

PATENT  
Docket No. 574411  
11-20-03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Jeffrey C. Östler et al.

Serial No.: 09/993,796

Filed: November 15, 2001

For: DELIVERY CHUTE SYSTEM FOR GRAVITY GAME

Examiner: Michael E. Butler

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Art Unit  
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TECHNOLOGY CENTER R3700

## RESPONSE

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Responsive to the Office Action dated July 31, 2003, Applicant hereby respectfully traverses Examiner's restriction requirement and requests reconsideration and withdrawal of the requirement for the reasons stated herein. In case the restriction requirement becomes final, Applicant hereby provisionally elects the claims identified by Examiner as "Group I" (Claims 1-8 and 19-26) for prosecution in the present application.

In the Office Action, Examiner proposes that two groups of claims, Group I (Claims 1-8 and 19-26) and Group II (Claims 9-18 and 27-33), represent distinct inventions and therefore should be restricted so as to require prosecution in separate applications. Applicant strongly disagrees with Examiner's reasoning and believes Examiner to be in error for several reasons.

First, Examiner fails to use the language of the claims when defining the inventions of Group I and Group II. *See MPEP 806.01*. Examiner states that the invention of Group I has an "un-metered gravity chute," and the invention of Group II in contrast has "aperture metering." However, not only are the terms "un-metered," "aperture," and "metering" conspicuously absent from the claims; they cannot be found anywhere in the specification as well. It is extremely puzzling that Examiner has used terms nowhere in the claims -- let alone the application -- to define the key difference between the two Groups that is supposed to make them distinct for purposes of restriction.

Second, Examiner wrongly characterizes Groups I and II as "subcombinations." Examiner says Groups I and II are "related as subcombinations disclosed as usable together in a single combination" are therefore distinct under MPEP 806.5(d) because Group I "has separate utility such as a merchandising display rack," and Group II "has separate utility such as a vending machine." However, a glance at the independent claims for each Group (Claims 1 and 19 for Group I, and Claims 9, 27, and 33 for Group II) reveals that all the claims of the application represent essentially the same embodiment. MPEP 806.03 states:

Where the claims of an application define the same essential characteristics of a *single* disclosed embodiment of an invention, restriction therebetween should never be required. This is because the claims are but different definitions of the same disclosed subject matter, varying in breadth or scope of definition.

Indeed, independent claims 1 and 19 of Group I contain a "slanted channel," a "delivery chute," and

a "transport" for transporting rounded articles or capsules. Independent claims 9, 27, and 33 of Group II also contain these elements and are otherwise clearly quite similar to the Group I independent claims, except that the Group II claims further specify a rotatable "disc" that Examiner apparently thinks causes the metered/un-metered differentiation that allegedly makes the inventions in Group I and Group II distinct. However, the mere inclusion of the disc in the Group II claims is certainly not enough to cause the Group I and Group II inventions to be so distinct so as to require restriction. Patent applications by nature are designed to have claims of varying scope, and the fact that some of the claims include a disc and some do not merely represents a variance in the breadth of the subject matter of Applicant's claimed invention. MPEP 806.03 is clear that restriction should never be required in these circumstances.

Third, even assuming Examiner has properly characterized Groups I and II as subcombinations, Examiner has wrongly identified the Group I and II inventions as having separate uses. Examiner states that Group I "has separate utility such as a merchandising display rack," and Group II "has separate utility such as a vending machine." However, the independent claims, Claims 1 and 19, of Group I read as follows:

1. A method for delivering articles comprising:
  - storing rounded articles in at least one slanted channel that opens into a delivery chute so as to allow said rounded articles to pass into said delivery chute;
  - transporting one of said rounded articles from said delivery chute via an article transport to a desired location for delivery of said rounded article therethrough; and
  - returning said article transport to its original position whereby the next, lowermost rounded article in said delivery chute drops into said transport in preparation for the next delivery.
19. A system comprising:
  - at least one slanted channel capable of receiving a plurality of rounded

capsules;  
a delivery chute, said slanted channel being open-ended so as to  
communicate with said delivery chute; and  
a movable capsule transport located beneath said delivery chute and adapted  
to transport at least one of said rounded capsules from said delivery  
chute to a desired location.

Applicant is at a complete loss as to how the inventions defined by these claims cannot possibly be characterized as having use as a vending machine. Both these claims include a device that holds articles and that mechanically transports one of these articles for delivery -- the very function of a vending machine (and, at any rate, these claims define a device that seems a lot more like a vending machine than a merchandising rack). Moreover, Applicant's specification specifically states that Applicant's invention can be used in vending machines. *See p. 9, lines 20-22*. The inventions of Group I and II do not have separate uses and are not distinct inventions.

Finally, even if Group I and Group II could properly be characterized as distinct inventions, MPEP 803 specifies that the examiner *must nevertheless examine* the entire application "if the search and examination of [the] entire application can be made without *serious burden*" (emphasis added). As was pointed out above, the claims in Group I and II are so similar in scope that it is difficult to see how the Group I claims and the Group II claims would require Examiner to perform two separate and significantly different searches. Again, the inclusion of additional detail (that is, the disc) in the Group II claims is certainly not enough to require a whole new search of a different scope, and is certainly not enough to make a search of the entire application a serious burden to Examiner.

For the foregoing reasons, Applicant respectfully traverses the restriction requirement and requests reconsideration and withdrawal of the same.

DATED this 31<sup>st</sup> day of October, 2003.

Respectfully submitted,



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